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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MAY 19, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re VTECH INDUSTRIES, L.L.C.

Serial No. 75/054,930

Herbert H. Finn of Dick and Harris for VTECH INDUSTRIES, L.L.C.

Steven R. Fine, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Hohein, Hairston and Holtzman, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

VTECH INDUSTRIES, L.L.C. has filed an application to register the mark "WHIZ KID ANIMATED" for "electronic game machines and programs for teaching of children".[1]

Registration has been finally refused on the ground that "the mark WHIZ KID ANIMATED is a 'mutilation' of the wording

[1] Ser. No. 75/054,930, filed on February 8, 1996, based upon an allegation of a bona fide intention to use the mark in commerce. The term "ANIMATED" is disclaimed. Following publication of the mark and issuance of a notice of allowance, applicant submitted a statement of use which alleges dates of first use of June 1996.

on the specimens, where it appears as TALKING WHIZ KID ANIMATED," and that applicant must therefore submit properly verified substitute specimens showing use of the mark WHIZ KID ANIMATED, as required by Section 1(a)(1) of the Trademark Act, 15 U.S.C. §1051(a)(1). Although applicant submitted identical copies of a catalog advertisement for its goods as its "specimens" of use, such advertising, which (in reduced size) is reproduced in pertinent part below, is acceptable as "specimens" of use inasmuch as it functions as facsimiles which depict how applicant actually uses the matter which it seeks to register.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

As a preliminary matter, we observe that there appears to be no disagreement by either applicant or the Examining Attorney with the long-standing principle that an applicant may apply to register any element of a composite mark displayed on the specimens of use if that element presents a separate and distinct commercial impression as a mark; that is, the element in and of itself functions as a mark since, as shown by the manner of its use on the specimens, it creates a separate impression which is indicative of the source of the applicant's goods or services and distinguishes such from those of others. See, e.g., Institut National des Appellations D'Origine v. Vintners International Co. Inc., 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992), *citing* In re Servel, Inc., 181 F.2d 192, 85 USPQ 257, 259-60 (CCPA 1950); In re Raychem Corp., 12 USPQ2d 1399, 1400 (TTAB 1989); Tekelec-Airtronic, 188 USPQ 694, 695 (TTAB 1975); and In re Berg Electronics, Inc., 163 USPQ 487, 487-88 (TTAB 1969).

Turning, therefore, to the merits of this appeal, applicant argues among other things that the words "WHIZ KID ANIMATED" are not a mutilation since they "create a separate and distinct commercial impression from the additional descriptive wording that appears on the specimens." In particular, applicant

contends, notably without any evidentiary support, that "[t]he term 'talking' is a merely descriptive term, denoting the fact that the device to which the WHIZ KID ANIMATED mark is applied generates human speech sounds." In view thereof, applicant insists that such term "is particularly insignificant to the distinctiveness and commercial impression of the mark WHIZ KID ANIMATED given the wide spread use of the term within the industry."

We concur with the Examining Attorney, however, that the word "TALKING" forms part of applicant's marks which share the words "WHIZ KID". Aside from the fact that the record, as the Examining Attorney points out, reflects that applicant is the owner of two prior registrations, involving the mark "TALKING WHIZ-KID" for an "electronic educational teaching game for children"[2] and the mark "TALKING WHIZ KID GENIUS" for an "electronic teaching game for children,"[3] which fail to contain a disclaimer of the assertedly descriptive term "TALKING," we note that even if applicant is correct that such designation is in fact a descriptive term for electronic devices that generate human speech," the words "Talking Whiz Kid" nevertheless appear together, each time in the same style and size of font, three separate times on the same page of its catalog advertising specimens. "It is obvious" therefrom, as the Examining Attorney contends, "that the applicant itself regards the 'name' of its

[2] Reg. No. 1,529,833, issued on March 14, 1989, which sets forth dates of first use of January 10, 1987; combined affidavit §§8 and 15.

product as TALKING WHIZ KID or TALKING WHIZ KID ANIMATED" rather than "WHIZ KID ANIMATED".

More importantly, the specimens reveal that, as shown on applicant's goods, the word "Talking" conspicuously appears in conjunction with the words "Whiz Kid," each of which is depicted in the same size of stylized lettering (with the first letter of each word capitalized), followed by the term "ANIMATED," which is shown in a larger and strikingly different stylized font (with all letters of the word capitalized). Given such stark contrast in visual presentation, we agree with the Examining Attorney that it is the words "TALKING WHIZ KID," rather than "WHIZ KID ANIMATED," which create a separate and distinct commercial impression as a mark for applicant's goods and thus, as evidenced by the specimens, the average "customer would perceive ... that the product is an 'animated' version of the applicant's TALKING WHIZ KID ... electronic game machines."

Decision: The refusal to register is affirmed.[4]

G. D. Hohein

P. T. Hairston

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[3] Reg. No. 1,860,461, issued on October 25, 1994, which sets forth dates of first use of May 10, 1993.

[4] Inasmuch as Trademark Rule 2.142(g) plainly provides, in pertinent part, that "[a]n application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer," applicant's alternative request in its brief that, if the Board does "not find the specimens ... submitted with Applicant's Statement of Use ... acceptable to demonstrate use of its WHIZ KID ANIMATED mark, ... the Board return the application to the Examining Attorney so as to ... amend the drawing in a non-material manner to reflect the TALKING WHIZ KID ANIMATED mark ..." is denied.

T. E. Holtzman
Administrative Trademark Judges,
Trademark Trial and Appeal Board